

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAKI KYOJIMA and KIL-HO SHIN

MAILED

AUG 28 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-1416
Application No. 09/678,031

ON BRIEF

Before FRANKFORT, OWENS and LEVY, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 1-48, which are all of the pending claims.

THE INVENTION

The appellants claim methods and systems pertaining to the issuance of an electronic license. Claim 1 is illustrative:

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1. A license-issuing method for issuing an electronic license for certifying that usage of digital contents is permitted to a specific user, the digital contents being provided by at least one of a provider and a seller, the method comprising:

generating information for verification from a license-issuing center, the license-issuing center being independent from the at least one of the provider and the seller, the information for verification required to verify legitimacy of an electronic license;

inputting information to specify the information for verification;

generating the electronic license from the license-issuing center, the electronic license able to be verified by the information for the verification specified by the input information to specify the information for verification; and

outputting the generated electronic license.

THE REFERENCE

Ginter et al. (Ginter) 5,892,900 Apr. 6, 1999

THE REJECTION

Claims 1-48 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ginter.

OPINION

The rejection is affirmed as to claims 1-3, 5-12, 14, 15 and 35-38, and reversed as to claims 4, 13, 16-34 and 39-48.

The reference

Ginter discloses a virtual distribution environment (VDE) that secures, administers and audits the use of electronic information (col. 2, lines 20-23). The VDE includes an information utility (200) that comprises a permissioning agent (200f) that "may distribute 'rules and controls' granting usage or distribution permissions based on a profile of a consumer's credit worthiness, for example" (col. 55, lines 53-56). The VDE also includes a content creator (102) and a rights distributor (106) that may be the same or different people (col. 56, lines 47-48). The content creator may specify rules and controls for distributing the content (col. 56, lines 7-8). The content creator sends the rules and controls to the rights distributor which may generate content usage rules and controls that are consistent with those of the content creator (col. 56, lines 12-24).

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Claims 1 and 2

The appellants argue that Ginter does not mention a license issuing center (brief, page 19). A license is a "permission to act".¹ The appellants do not rely upon any more limited definition of "license". Hence, Ginter's permissioning agent, which distributes rules and controls granting usage or distribution permissions (col. 55, lines 53-56), is a "licensing issuing center" as that term is used by the appellants.

The appellants argue that Ginter does not disclose a licensing issuing center that is independent of at least one of a content provider and a content seller (brief, page 19). Ginter discloses that the participants in the information utility, one of which is the permissioning agent, each can be an independent organization or business (col. 55, lines 37-38), and that the information utility can be a central entity to which other entities including an author (which corresponds to the appellants' provider) and a publishing house (which corresponds to the appellants' seller) are electrically connected (col. 54,

¹ Webster's New Collegiate Dictionary 662 (G. & C. Merriam 1973).

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lines 63-64; figure 1). The disclosure that the permissioning agent can be an independent organization or business and the illustration of the permissioning agent as electrically connected to separate provider and seller entities would have fairly suggested, to one of ordinary skill in the art, a permissioning agent that is independent of the provider and seller.

The appellants argue that Ginter's disclosure that each information utility participant can be an independent organization or business merely identifies the participants as being independent from each other, and does not indicate that they are independent from the provider or seller (reply brief, page 4). Ginter's disclosure that the participants are independent does not limit that independence to independence among the participants. Furthermore, Ginter's figure 1 indicates that the participants, one of which is the permissioning agent, are independent from the author (provider) and publishing house (seller).²

² The appellants incorrectly argue that Ginter's disclosure that the video production studio (204) may provide rules and controls for a video and may, through the information utility, make the video available in protected form to consumers (col. 54, lines 39-44) indicates that the information utility is not independent from the video production studio (reply brief, page 4). The rules

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For the above reasons we are not convinced of reversible error in the examiner's rejection of claims 1 and 2, and their dependent claims 3, 8, 35 and 36 that are not separately argued by the appellants (brief, pages 25-27).

Claims 5-7

Claims 5 and 6 require a license issuance history memory unit and a content provider's issuance history preparation unit. Claim 7 requires a verification information issuance history memory unit for storing a history of issuance of information for verification, a verification information issuance history preparation unit which receives information to specify a recipient of information for verification and extracts the issuance history, and a verification information issuance history output unit for outputting the issuance history.

The examiner argues that Ginter discloses those claim requirements at column 20, line 42 and column 24, lines 24-53 (answer, pages 8-9). Column 20, lines 39-43 discloses: "This

and controls provided by the video production studio are in addition to those provided by the information utility and, therefore, do not make the information utility dependent upon the video production studio.

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same provider might also charge fees based on the total number of different properties licensed from them by the user and a metering history of their licensing of properties might be required to maintain this information." Column 24, lines 24-53 discloses the use of bitmap meters to record usage and/or purchase of information.

Regarding claim 5 the appellants argue that Ginter does not disclose means for obtaining a metering history (brief, page 25). The appellants apparently are referring to their content provider's issuance history preparing unit, which is the limitation argued with respect to claim 6. *See id.* Ginter's system necessarily requires a unit for preparing the metering history disclosed at column 20, lines 41-42. Hence, we are not convinced of reversible error in the examiner's rejection of claims 5 and 6.

As for claim 7, the appellants assert that the units recited in that claim are not disclosed in the portions of Ginter relied upon by the examiner (brief, page 25). The metering history disclosed by Ginter at column 20, lines 39-43 necessarily

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requires units for storing, extracting and outputting metering history information. Any difference between the metering history information in the appellants' claim 7 and that of Ginter does not patentably distinguish the claim over Ginter because the information is nonfunctional descriptive material, i.e., it does not have any new and unobvious functional relationship with the substrate on which it is stored. See *In re Gulack*, 703 F.2d 1381, 1386, 217 USPQ 401, 404 (Fed. Cir. 1983). Consequently, we are not convinced of reversible error in the examiner's rejection of claim 7.

Claims 9-15

Regarding claims 9 and 10, the appellants argue that Ginter does not disclose "not only receiving a first license request, but also preparing a second license request requesting issuance of the electronic license requested in the received first license request, and outputting the second license request to the independent license-issuing center" (brief, page 20).

The request from Ginter's customer to the seller corresponds to the appellants' first license request. The request by the

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seller to the permissioning agent for permission to provide the content requested in the first license request corresponds to the appellants' second license request requesting the issuance of the license requested in the first license request.

We therefore are not convinced of reversible error in the examiner' rejection of claims 9 and 10, and their dependent claims 11, 12, 14, 15, 37 and 38 that are not separately argued by the appellants (brief, page 26).

The appellants argue that Ginter does not disclose the agreement storage means in claim 13 (brief, page 26). The examiner argues: "Ginter further discloses that negotiations, contracts, and agreements governing licensing, distribution, and use of content are all possible with his system, incorporated into the data 'objects' transmitted among participants of his 'chain of handling and control' (see above citations)" (answer, page 10). The "above citations" referred to by the examiner cover many columns and figures in Ginter. The examiner has not pointed with any degree of particularity to any part of Ginter and explained how that disclosure would have fairly suggested, to

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one of ordinary skill in the art, the agreement storage means required by the appellants' claim 13.

Consequently, we conclude that the examiner has not established a *prima facie* case of obviousness of the invention claimed in the appellants' claim 13.

Claims 4 and 16-19

Claims 4 and 16-19 require an intermediary of the issuance of an electronic license.

The examiner does not point to any disclosure in Ginter of such an intermediary but, rather, cites Ginter's abstract, eight figures and associated text, and approximately twenty other columns (answer, page 5). The examiner's citation of numerous columns and figures in Ginter without explaining how the relied-upon portions disclose, or would have fairly suggested to one of ordinary skill in the art, Ginter's intermediary, is not sufficient for establishing a *prima facie* case of obviousness of the inventions claimed in the appellants' claims 4 and 16-19.

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Claims 20-34 and 39-48

Regarding claims 20-34 and 39-48 the examiner states what the claims recite and cites at least seventeen columns of Ginter (answer, pages 5-7 and 12). The examiner' citation to a large portion of Ginter without pointing out with reasonable particularity the relied-upon disclosures and explaining how they disclose, or would have fairly suggested, to one of ordinary skill in the art, the limitations in the appellants' claims, is not sufficient for establishing a *prima facie* case of obviousness.

DECISION

The rejection of claims 1-48 under 35 U.S.C. § 103 over Ginter is affirmed as to claims 1-3, 5-12, 14, 15 and 35-38, and reversed as to claims 4, 13, 16-34 and 39-48.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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